

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Henri ROSSET et al.**

Art Unit: **3725**

Application Number: **10/584,763**

Examiner: **Pradeep Choudary Battula**

Filed: **June 28, 2006**

Confirmation Number: **5785**

For: **SECURITY PAPER HIGHLY RESISTANT TO DOUBLE FOLDING
AND METHOD FOR MAKING SAME**

Attorney Docket Number: **062723**

Customer Number: **38834**

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

June 18, 2009

Sir:

This paper is submitted in response to the Office Action dated May 20, 2009.

In the Office Action, Applicants are required to elect one of the following groups of claims for prosecution in this application:

- (I) Claims 1-13 drawn to a security paper
- (II) Claims 14-19 drawn to a process for manufacturing a security paper

Applicant(s) hereby elect(s) the subject matter of **Group (I), Claims 1-13** for prosecution in this application. This election is made **with traverse**, as set forth below.

It is understood that Applicants' rights to the filing of a divisional application directed to the non-elected subject matter under 35 U.S.C. §120 and 35 U.S.C. §121 are retained.

The restriction requirement is respectfully traversed. Contrary to the assertion made in the Office Action US 3,256,138 to Welch et al. ("Welch"), and in particular the passage at col. 2, lines 36-58 of Welch, does not disclose a paper as recited in present claim 1.

Specifically, in Welch, plastic particles are spread but they are subsequently made to flow into a continuous resin layer by heating and calendaring. In other words, the resin particles must first be melted and destroyed to join the paper layers. Thus, Welch does not disclose both (i) an element in diffuse or particle form and (ii) an interlayer intimately joined to the two plies, as recited in present claim 1. Accordingly, present claim 1 is not anticipated by Welch and a common special technical feature is present, at least in that the process of claim 14 is specially adapted to manufacture the product of claim 1. See Rule 13 PCT and 37 C.F.R. 1.475(a).

Further, the issue of whether dewatering and mat-forming steps as recited in claim 14 are not required in claim 1 is not relevant to the “unity of invention” inquiry under Rule 13 PCT and 37 C.F.R. 1.475(a).

Further, it is submitted that the issue whether the product could be manufactured with a different process, or whether the process could be performed to manufacture a different product, is not relevant to the “unity of invention” inquiry under Rule 13 PCT and 37 C.F.R. 1.475(a).

In view of the above, it is submitted that the restriction requirement should be withdrawn and all claims examined together in this application.

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If this paper is not timely filed, Applicant(s) respectfully petition(s) for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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